

REMARKS

Claims 1-19 and 21-27 are pending in the application. Claims 1-19 and 21-27 are rejected under 35 U.S.C. §102(b) and §103(a).

The Rejection Under 35 U.S.C. §102(b)

Claims 1, 3-10, and 21-23 are rejected under 35 U.S.C. §102(b) as being anticipated by Perronin, U.S. Patent No. 3,991,007. The Examiner states:

*Perronin discloses the preparation of pigmentary particules coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 11 provides a composition with 100 parts pigment, 350 parts heptane, 27 parts methyl methacrylate, and 12 parts acrylic acid.*

With respect to the preamble of Applicants' claims specifying a nail enamel composition, the Examiner contends *that the preamble "nail enamel composition" does not hold any patentable weight without reciting a structural limitation.*

Applicants respectfully disagree, first noting that claim 1 has been amended to specify that the polymer *is capable of forming a film on the nail*. Support for this change is found on page 4, line 20 of the specification. This provides a structural limitation in the body of the claim, as requested by the Examiner. Accordingly, both the preamble and the characterization of the polymer as one that forms a film on the nail must be considered as limitations.

Perronin teaches preparation of pigment compositions by first polymerizing one or more ethylenically unsaturated monomers with pigment particles to form pigments coated with the polymer. The desired monomers, pigment, and appropriate solvent are combined and polymerization is initiated by increasing the temperature. Perronin teaches that the resulting pigment mixture is very useful in printing inks. Perronin does not teach nail enamel compositions. The preamble of claim 1 as well as the reference to "nail" in the body of the claim are both limitations that must be considered; limitations which are not present in Perronin.

It has been well established that the standard for lack of novelty (anticipation) is one of strict identity. To anticipate a claim for a patent, a single prior art reference must contain all its essential elements. Hybritech vs. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). The exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference. Tights, Inc. v. Acme-Mcrary Corp., 541 F.2d 1047, 191 U.S.P.Q. 305 (4th Cir. 1976). Because amended claim 1 contains limitations not found in Perronin, this reference cannot anticipate.

Claims 3-10 depend on claim 1, either directly or indirectly. Since claim 1 is not anticipated by Perronin claims 3-10 are not anticipated.

Claims 21-23 also depend on claim 1, and for the same reasons are not anticipated.

Applicants further note that new claims 28-36 have been added. Claims 28-34 are claims directed to nail enamel compositions containing a solvent and very specific types of film forming polymers that are capable of forming a film on the nail. Claims 35-36 are method claims where

the nail enamel composition and the topcoat composition have specific film forming polymers present therein. None of these new claims are anticipated by Perronin, which does not teach nail enamel compositions.

Claims 1-19 and 21-27 are rejected under 35 U.S.C. §102(b) as anticipated by Pagano, U.S. 5,772,988. The Examiner contends that:

*Pagano et al disclose a nail composition containing butyl acetate, a copolymer with a polar monomer (acrylic acid) and a nonpolar ethylenically unsaturated monomer, pigments, a suspending agent (stearalkonium bentonite), silicone glycol copolymer, and a plastizer (glyceryl tribenzoate) in instant amounts (Note examples). Monomer A (ethylenically unsaturated monomer) is in the amount of 30-95%, monomer B (acetoacetoxy moieties) in the amount of 5-50%, and monomer C (acrylic acid) in the amount of 1-20%. Note column 5, lines 24-29. Monomer B is contained in 20% in the examples. Further, Pagano teaches an aqueous nail enamel composition (Note Example 8). The composition can be in a kit (Note example 1) with a cellulose polymer. The nail enamel was tested and has instant nail residual effect.*

The Examiner further notes:

*since the applicant has not defined "substantially free" in the specification, it is the examiner's position that less than 50% reads on "substantially free".*

Applicants note that they have amended claim 1 to specify that the composition is "free of" acetoacetoxy moieties. Support for this change is found throughout the specification and examples of the pending application where it is clear that the polymers do not contain acetoacetoxy moieties as taught in Pagano's monomer B. Claims 2-16 depend on claim 1, either directly or indirectly.

Pagano teaches a terpolymer, or a polymer that is obtained by polymerizing at least three monomers A, B, and C. While monomer A in Pagano is a nonpolar monomer, and monomer C

is a polar monomer, the presence of monomer B is critical to the Pagano polymer composition. Monomer B is acetoacetoxy ethylmethacrylate (see column 6, lines 25-27 of Pagano). In amended claim 1, the polymer is "free of" monomers that contain acetoacetoxy moieties. Claims 2-16 depend on claim 1 either directly or indirectly, so also contain this limitation.

Claim 17 is directed to a two component kit for painting the nails. The claim has been amended to specify that the film forming polymer in the nail enamel found in the first container is the composition defined in amended claim 1 which is "free of" acetoacetoxy moieties. While Pagano teaches two component kits, the kits taught must contain, in one container, the film forming terpolymer taught by Pagano. Claim 18 depends on claim 17 and if claim 17 is not anticipated by Pagano, claim 18 cannot be.

Claim 19, a method claim, has also been amended to clarify that the nail enamel composition in container one is as described in claim 1, which is "free of" acetoacetoxy moieties.

All of the claims now specify that the polymer used in the nail enamel compositions is "free of" acetoacetoxy moieties, rather than "substantially free". Accordingly, these claims contain limitations that are not found in Pagano, thus this reference cannot anticipate.

New claims 28-34 are directed to nail enamel compositions containing very specific copolymers. For example, new claim 28:

*A nail enamel composition comprising, by weight of the total composition:*

*10-95% solvent, and*

*5-95% of a copolymer capable of forming a film on the nail, having a glass transition temperature in the range of 5 to 90° C., and consisting of butyl methacrylate copolymerized with a polar monomer selected from the group consisting of acrylic acid, methacrylic acid, and mixtures thereof.*

The polymer in the above claim consists of butyl methacrylate and acrylic acid, methacrylic acid, and mixtures thereof. In other words, there are no other monomers in the polymer other than those mentioned. Clearly this claim is not anticipated by Pagano, which teaches a terpolymer containing acetoacetoxy monomers.

Claim 29 depends on claim 28 and further specifies the percentage of butyl methacrylate and the polar monomer present.

New Claim 30 also depends on claim 28 and further specifies the percentage of the butyl methacrylate and methacrylic acid present.

Claim 31 is directed to a nail enamel composition where the copolymer consists of methyl methacrylate and a polar monomer which is selected from the group consisting of acrylic acid, methacrylic acid, or mixtures thereof. Claim 32 further specifies that the polymer contains 2-29% by weight of the polymer of acrylic acid with the remainder of the polymer being methylmethacrylate.

Claim 33 is directed to a nail enamel composition where the polymer consists of only certain enumerated monomers and none others. Claim 34 further specifies the percentage of the monomers present.

Claim 35 is directed to a method for polishing the nails where the polymer present in the first composition is a specific polymer that consists of certain enumerated monomers and no others, and which does not contain acetoacetoxy moieties. Claim 36 depends on claim 35 and further specifies that the film forming polymer in the second composition is nitrocellulose.

All of the above new claims are not anticipated by Pagano because the polymer present in the nail enamel composition consists of only the monomers mentioned, none of which contain acetoacetoxy moieties.

It is Applicants' position that the amendments to claims 1-19 and 21-27 which specify that the polymer found in the nail enamel is *free of* acetoacetoxy moieties, and the newly submitted claims which identify very specific polymers that do not contain monomers other than those set forth, are not anticipated by Pagano. In all cases, the claims contain limitations that are not found in Pagano, thus this reference cannot anticipate.

Applicants respectfully request the Examiner to reconsider the rejection of claims 1-19 and 21-27, and the patentability of newly submitted claims 28-36 under 35 U.S.C. §102(b).

The Rejection Under 35 U.S.C. §103(a)

Claims 1-19 and 21-27 are rejected under 35 U.S.C. §103(a) as unpatentable over Pagano.

The Examiner summarizes the teachings of Pagano, and notes that *Pagano teaches the range of monomer B to be from 5-50% and exemplifies 20%; further noting that he [Pagano] does not exemplify the minimum end of the range. Assuming that Applicants can provide support that "substantially free" is less than the exemplified 20%, it is deemed obvious to one of ordinary skill in the art at the time the invention was made to manipulate the parameters of Pagano et al and include monomer B in the lower weight percent, i.e. 5%. One would be motivated to do so with the expectation of similar results since Pagano provides general guidance in making the copolymer and the suitable weight percent of the monomers contained in the copolymer.*

The Examiner concludes:

*....it is the Examiner's position that the lower range of the weight percent of monomer B reads on "substantially free" since applicant has not provided the parameters of substantially free and since Pagano's copolymer contains monomer A (instant polymer) in a greater quantity (30-95%).*

Applicants respectfully disagree, first noting that the claims have been amended to specify that the polymer is "free of", not "substantially free", but "free of" acetoacetoxy moieties. This means that the polymer present in the nail enamel compositions does not contain any of Pagano's Monomer B. With respect to the newly submitted claims, in each case the polymer is described as "consisting of" certain enumerated monomers, none of which are acetoacetoxy monomers. This amendment further distinguishes the claims over Pagano, and addresses the Examiner's contention that the Declaration submitted with the previous response is not commensurate in scope with the claims. Such Declaration is now commensurate in scope with the claims.

It is Applicants position that the amended and newly submitted claims under not obvious over Pagano. In re Marosi, Stabenow, and Schwarzmann, 710 F.2d 799,803; 218 U.S.P.Q. 289, 291-292 (Fed. Cir. 1983) stands for the proposition that a person of ordinary skill in the art would reasonably expect that if what was taught as an essential ingredient is not included an undesirable reaction or no reaction at all would occur. Accordingly, one skilled in the art would expect that if Pagano's B monomer is removed from the terpolymer a most undesirable result would occur because Pagano teaches the criticality of a polymer containing this B monomer.

However, as evidenced in Applicants' Declaration, submitted removal of the B monomer from the polymer used in the claimed composition not only results in a composition that provides excellent wear and adhesion, but a composition that does not yellow the nails of individuals who choose to use formaldehyde based nail products. Under the rule of In re Marosi, the skilled artisan would expect quite the opposite.

The Examiner's comments in the Response to Arguments section beginning on page 5 of the Office Action with respect to "substantially free" and the Declaration submitted not being commensurate in scope with the claims, is addressed above. The Examiner further states:

*Applicant bases patentability on the use of two specific types of monomers and the subsequent polymerization to produce a polymer composition with the non-yellowing ability as discussed in Rule 132 Declaration. This non-yellowing property is not recited in the instant claims. As recognized by the applicant, Pagano teaches a polymer composition containing at least two different monomers and instant claims require two different monomers. Further, Pagano teaches the monomers of instant structure. Therefore, Pagano reads on instant claims since instant claim language does not exclude other monomers in the composition. Lastly, applicant uses the term "well-wear" which is also recognized by Pagano in general terms on column 9, lines 29-34.*

Applicants respectfully point out that the amended and newly submitted claims are directed to a nail enamel composition where the polymer is free of acetoacetoxy monomers. In the amended claims the polymer has been characterized as "free of" acetoacetoxy-containing monomers. In the newly submitted claims, the polymer is specifically defined as "consisting of" certain enumerated monomers. The term "consisting of" is a closed term, meaning that the monomers enumerated are the only ones present and that the polymer does not contain any monomers that are not stated in the claim. Accordingly, Pagano does not read on the claims.



Further the Declaration submitted with Applicants' prior response shows the superiority of the claimed compositions when compared with those of Pagano in terms of yellowing. In particular, the Pagano compositions tend to yellow the nails while the compositions of the invention, containing a film forming polymer that is "free of" acetoacetoxy monomers does not. Applicants do not need to add any limitation about non-yellowing to their claims because the claims have been amended to remove the moiety (the acetoacetoxy monomer) that caused the yellowing.

As regards the Examiner's comment about "well-wear", the term "wear" is often used by experienced nail enamel formulators when referring to one very important property of nail enamel, which is wear. If nail enamel wears well, that means that it exhibits a comparatively good degree of wear on the nails (when considering parameters such as tip wear and chipping) which would not be seen as readily in a nail enamel composition that did not wear well. The fact that both Pagano and Applicants' specification refer to wear, and mention that both compositions "wear well" is nothing more than a general statement similar to those made by many other nail enamel manufacturers; scientifically meaningless unless data and comparative information is supplied, which Applicants have done.

It is Applicants' position that the amended and newly submitted claims are patentable under 35 U.S.C. §102(b) and §103(a). These claims contain limitations that are not found in Perronin and Pagano, thus those references cannot anticipate. With respect to the §103(a) rejection over Pagano, Applicants' claims specifically exclude an ingredient that Pagano teaches

is essential, and Applicants have supplied comparative data showing the superiority of their claimed compositions when compared with those of Pagano.

The Examiner is respectfully requested to reconsider the rejection of the claims under 35 U.S.C. §102(b) and §103(a).

Respectfully Submitted,



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